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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,060	05/19/2000	Babu J. Mavunkel	21900-20290.00	1599

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/575,060

Applicant(s)

MAVUNKEL ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 26 February 2002 and 29 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-6,9,11,12,16-42 and 45-84 is/are pending in the application.
- 4a) Of the above claim(s) 40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6,9,11,12,15-21,29-33,36-39,42 and 61-84 is/are rejected.
- 7) ☐ Claim(s) 22-28,34,35 and 45-60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Amendment and response and a supplemental amendment filed by applicants in Paper No. 12 dated Feb. 26, 2002 and Paper No. 14, dated Mar. 29, 2002 have been entered and considered carefully. Claims 7-8, 10, 13, 14-15 43-44 have been canceled. Claims 1-6, 9, 11-12, 16-42, 45-84 are pending.
2. The rejection of claims 8, 30 and 38 for improper dependency is dropped in view of incorporation of the R<sup>7</sup> and H<sup>1</sup> in the base claim.
3. The rejection of claim 42 under 35 USC 112 second paragraph is dropped in view of the amendment incorporating the target being treating rheumatoid arthritis in a subject.
4. The rejection of claim 1 under 35 USC 112 first paragraph over L1 and L2 is dropped in view of the incorporation in claim 1 of the particular Markush elements for l1 and l2. However, a new matter rejection is hereby necessitated.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Please note that the L1 and L2 parameters have been amended to be alkylene or alkenylene linkers which was described on page 5 to be (CH<sub>2</sub>)<sub>n</sub>-R, and n is 0-3 as defined by the specification. Therefore, the amendment wherein l1 and L2 are alkylene or alkenylene of C1-4 is new matter since such description was not encompassed by p.6 line 26 to page 7 line 18 nor was it encompassed by the page 5 description.

This is a NEW MATTER rejection. Removal of all new matter is required. In re Ressemussen 211 USPQ 325.
5. The objection of claim 38 for improper incorporation of description into the claims by express reference to specification is maintained for reason of record and also applicable to the newly added claims 61-84. Please note the decision as recited in the previous office action on

Art Unit: 1625

p.1609 it was state"...incorporation by reference to a specific figure or table....is permitted only in exceptional circumstances where there is no practical way to define the invention in words..."

It is noted that the reference to the specification of table 2 and 3 are compounds for which each can be named or structure be drawn. In addition, compounds of table 2 and 3 included non-elected piperidinyl compounds which do not read on the base claim. Therefore, it is proper for applicants to clean up the claims and incorporate appropriate nomenclature or structure for each claim.

6. The rejection of claims 1-9, 11-12, 15-21, 29, 31-33, 36-37, 39-41 under 35 USC 103(a) over JP 09124631 is maintained for reason of record because the newly amended claims contain new matter and the scope of the claim after removing of new matter is unclear. Please note that benzofuran and indole are aromatic rings with similar size and the utility of JP 09124631 is identical to the instant compounds when L2 is C<sub>0</sub>/bond as the claims now amended.

An oversight was discovered that claims 40-41 are multi-active ingredient composition which depends on the combination of active ingredients for patentability instead of merits of the compounds for patentability, thus, are withdrawn from consideration. Please note that monoclonal antibody is biological material and is not required for search of compounds.


Claims 22-28, 34-35 remained and claims 45-60 newly added are objected to.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CCPC/Chang  
May 30, 2002

  
Celia Chang  
Primary Examiner  
Art Unit 1625